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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,632	05/02/2001	Ulrich Sander	LAGP:102_US_	6611

24041 7590 02/06/2002
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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 02/06/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

09/847,632

Applicant(s)

SANDER, ULRICH

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on th cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings contain three sheets of figures 1-3 filed on 05/02/2001 have been received by the Office.

Specification

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The disclosure is objected to because of the following informalities: The Summary of the Invention is objected to because it refers to the claims and other sections of the specification for the purpose of providing a brief technical description of the invention. Appropriate correction is required.
5. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to provide a proper antecedent basis for the type of operable drive system as recited in claim 5.

Claim Objections

6. Claims 1 and 3 are objected to because of the following informalities.

Appropriate correction is required.

a) In claim 1: on line 1, "the subject" should be changed to --a subject--. The reason for that suggestion is that the claim with the mentioned terms is indefinite because it does not provide a proper antecedent basis for the feature "the subject";

b) In claim 3: on line 1, "the position" should be changed to --a position--. See the reason as set forth in element a) above.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 6-8 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 6 is rejected under 35 USC 112, first paragraph because the specification does not disclose a system having a mirror prism and a light-concentrating system fixed thereto wherein at least a portion of the light-concentrating system is removed by a mechanism. Applicant is respectfully invited to review the specification at page 4. In particular, in the paragraph

[0021], the lens (11) is able to remove when it is not cemented to the mirror prism (10), and in the paragraph [0025], the lenses (9, 11) are able to remove; however, the paragraph does not teach that the lenses are fixed to the mirror prism.

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

9. Claims 11-15 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Claim 11 is rejected under 35 USC 112, first paragraph because the claim is a single means claim. The claim fails to be limited to the disclosure of specific elements and equivalents thereof in the specification, and is thus boarder than the enablement of that disclosure. See *In re Hyatte*, 708 F.2d 712 (Fed. Cir., 1983).

b) The remaining claims are dependent upon the rejected base claim and thus inherit the deficiencies thereof.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-
(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

11. Claims 1, 3 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Engelhardt et al (U.S. Patent No. 6,285,019).

Engelhardt et al disclose a microscope having an illuminating system. The light from a light source (2) is guided through a plurality of optical components (6, 8, 10) to illuminate an object (3) via an objective lens system (11). The assembly of optical elements (8) is a motorized zoom optical assembly which is used to adjust the position of focus, or for continuous variation of the focus. As such, a change in movement of the zoom optical assembly will convert the light from the light source (2) into a focus or defocus fashion on the object (3). See column 3 and the single-figure.

Claims 1-3 and 9 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kleinberg (U.S. Patent No. 5,155,509).

See Kleinberg, columns 3-4 and figs. 2-3.

13. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by Biber et al (U.S. Patent No. 4,715,704).

Biber et al disclose a surgical microscope having an illuminating system. The light from a light source (1) is guided through a plurality of optical components (2, 3, 63, 65) to illuminate an eye (67) via an objective lens system (59). A

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mechanism for providing a swinging movement of the field stop (3) on a pivot or a sliding movement on a track with respect to the illuminating light path will cause a darkening on the eye to be illuminated. See column 2 and the single figure.

14. Claims 1-2, 4 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakazeki et al (U.S. Patent No. 5,260,965).

Nakazeki et al disclose an optical system having an illuminating system for viewing an object. The illuminating system comprises two light sources (5 and 4) which provide light of different wavelengths. The optical system comprises a beam forming device (2), an aberration compensating device (9), a beam-splitter (1e), and an objective lens system (1b-1d). The aberration compensating device is operated for the purpose of making the focal point of the light emitted from the visible light source (5) on the same location as the focal point of the light emitted from the laser source (4). When the light source (5) is used then the aberration compensating system is operated to place the space portion (9b) in the light path. As such, it is clear that a movement of the compensating device to place the convex lens portion (9a) in the optical path when the light source (5) is used will cause a darken in the object. In the same opinion, when the laser source (4) is used then the aberration compensating system is operated to place the convex lens portion (9a) in the light path. As such, it is clear that a movement of the compensating device to place the space portion (9b) in the optical path when the laser source (4) is used will cause a darken in the object.

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Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 11 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Engelhardt et al.

Engelhardt et al disclose a microscope having an illuminating system. The light from a light source (2) is guided through a plurality of optical components (6, 8, 10) to illuminate an object (3) via an objective lens system (11). The assembly of optical elements (8) is a motorized zoom optical assembly which is used to adjust the position of focus, or for continuous variation of the focus. As such, a change in movement of the zoom optical assembly will convert the light from the light source (2) into a focus or defocus fashion on the object (3). See column 3 and the single figure. The only thing missing from the art of Engelhardt et al is that they do not explicitly state a method for adjusting the position of the illuminating light on the object. However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope provided by Engelhardt et al by setting forth a set of steps including the step of moving at least one lens element of the assembly (8) for the purpose of adjusting the

position of the focus point on the object. It is also noted that the movement of the assembly will cause a darkening on the object in a defocus process.

17. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Biber et al.

Biber et al disclose a surgical microscope having an illuminating system. The light from a light source (1) is guided through a plurality of optical components (2, 3, 63, 65) to illuminate an eye (67) via an objective lens system (59). A mechanism for providing a swinging movement of the field stop (3) on a pivot or a sliding movement on a track with respect to the illuminating light path will cause a darkening on the eye to be illuminated. See column 2 and the single figure. The only thing missing from the art of Biber et al is that they do not explicitly state a method for adjusting the position of the illuminating light on the object.

However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope provided by Biber et al by setting forth a set of steps including the step of moving at least one lens element of the assembly (8) for the purpose of adjusting the position of the focus point on the object. It is also noted that the movement of the assembly will cause a darkening on the object in a defocus process.

18. Claims 5 and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakazeki et al.

Nakazeki et al disclose an optical system having an illuminating system for viewing an object. The illuminating system comprises two light sources (5 and 4)

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which provide light of different wavelengths. The optical system comprises a beam forming device (2), an aberration compensating device (9), a beam-splitter (1e), and an objective lens system (1b-1d). The aberration compensating device is operated for the purpose of making the focal point of the light emitted from the visible light source (5) on the same location as the focal point of the light emitted from the laser source (4). When the light source (5) is used then the aberration compensating system is operated to place the space portion (9b) in the light path. As such, it is clear that a movement of the compensating device to place the convex lens portion (9a) in the optical path when the light source (5) is used will cause a darken in the object. In the same opinion, when the laser source (4) is used then the aberration compensating system is operated to place the convex lens portion (9a) in the light path. As such, it is clear that a movement of the compensating device to place the space portion (9b) in the optical path when the laser source (4) is used will cause a darken in the object.

The only thing missing from the art of Nakazeki et al is that they do not explicitly state that the driving system for controlling the operation of the aberration compensating device is the so-called "electromechanically" drive system.

However, the use of any suitable driving system for rotating a disc or a revolver about a rotational axis including an electromechanically drive system is clearly within the level of one skilled in the art. With regard to the method as claimed in claims 11-13, while Nakazeki et al do not clearly state a method for darkening an object. However, it would have been obvious to one skilled in the art to recognize

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that a movement/operation of the aberration compensating device (9) without knowledge of the type of light source being used will result in a darken of the object to be illuminated. As such, it would have been obvious to one skilled in the art at the time the invention was made to utilize the device provided by Nakazeki et al by controlling the operation of the aberration compensating device and the light sources so that (s)he can focus the light beams onto a common point or for providing a darken on the object to prevent the damage to the object by the intensity of illuminating light.

19. Claims 11 and 14, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Kleinberg.

Kleinberg discloses a microscope having an illuminating apparatus for illuminating a patient's eye. The illuminating system comprise a module having a set of mirrors (38 and 42) which module is able to slide into the illuminating path and remove therefrom. As stated at column 3, the entering of the module will reduce a portion of the eye from directly illumination and thus reducing the damage to that portion of the eye. Such a result is obtained due to the darken covered that portion due to the change in the illumination to the eye. It is also noted that the mirror (42) is able to pivot for the purpose of changing the direction of the oblique illumination. The only thing missing from the art of Kleinberg is that he does not explicitly state a method for adjusting the position of the illuminating light on the object. However, it would have been obvious to one skilled in the art at the time the invention was made to utilize the microscope

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provided by Kleinberg by setting forth a set of steps including the step of moving the module and/or pivoting the second mirror located inside the module for the purpose of adjusting the position of the focus point on the object. It is also noted that the movement of the pivotal mirror will cause a darkening on the object in a defocus process.

Conclusion

20. The additional references are cited as of interest in that each discloses a microscope having an illumination system comprises a plurality of optical elements wherein one optical element is able to move along the illuminating path or pivot with respect to the illuminating path to change the position of a focus point.


21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is 703 308 4814. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cassandra Spyrou can be reached on 703 308 1687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 7724 for regular communications and 703 308 7724 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.

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Thong Q. Nguyen
Primary Examiner
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January 31, 2002